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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,081	01/07/2002	Jonathan D. Levine	D/A1202;690-010417-US (PA)	2426
7590 09/25/2006			EXAMINER	
Clarence A. Green Perman & Green, LLP, 425 Post Road Fairfield, CT 06430			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/041,081	Applicant(s) LEVINE, JONATHAN D.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the remarks filed on 7/19/2006.

This action is made Final.

2. In the remarks, claims 1-38 are pending in the case. Claims 1, and 20 are independent claims.

Drawings

3. The drawings filed on 1/7/2002 have been approved by the examiner.

Claim Objections

4. The objection of claim 7 has been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, and 20 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite "*in a universal format, devoid of said customized formatting and any particulars unique to an originator of said complete book file*" lines 8-10, and 10-12 respectively. It is still unclear what is meant by the language, since the book is customized by an originating author. The author specifies the content, layout, etc., to be

included in the book. Therefore, it appears that the book would retain those characteristics specified by the originator regardless of what intermediate format the book is converted into. This would make the book not *devoid of said customized formatting and any particulars unique to an originator of said complete book file*. The Applicant submit that “A universal format, as referred to in this application is a digital file, in which the digital structure and codes of the originating software, hardware and operating system is absent(page 8). These components may be collectively referred to as the originating platform. In print-on-demand publishing, to which this application relates, the publishing process involves more than a collection of content, but also relates to the packaging and distribution of the content”. The Applicant is invited to introduce the language above to clarify the vague language of the claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 9-22, and 28-38 remain rejected under 35 U.S.C. 102(e) as being anticipated by Warmus et al, hereinafter Warmus (Pat.# 6,332,149 B1, 12/18/2001, filed on 2/11/1997).

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Regarding independent claim 1, Warmus discloses the development of a template file representing pages of book(s) to be reproduced. The file contains fixed, and variable information indicating customized information to be inserted into the file—*receiving as a complete book file digital, including a book block, a digital representation with customized formatting* -- (col. 10, lines 45-67).

Moreover, Warmus discloses converting the stripped template file into a PDL file—*converting said book files to have a solution-independent, intermediate format, in a universal format, devoid of said customized formatting and any particulars unique to an originator of said complete book file* (col. 10, lines 45-67, col.11, lines 1-10). The file contains information specifying the positioning of fixed information—*storing said solution-independent, intermediate formatted book file along with book identification information*(generic or independent format with information identifying fixed positioning) *as a mastered book*.

Moreover, Warmus discloses premerging master PDL files with variable files before being provided to the printer —*converting said solution-independent, intermediate formatted book file to solution-dependent (premerged file) formatted book file* -- (col. 11, lines 47-51).

Furthermore, Warmus discloses using commands in a press file to create the finished books or book versions —*reproducing said book* -- (col. 11, lines 45-51).

Regarding claim 2, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced —*said book is in the form of electronic files* -- (col. 10, lines 45-67).

Regarding claim 3, which depends on claim 1, Warmus discloses scanning book pages into a system and printing them over a network –*scanning and converting scanned components into said digital representation* -- (col. 8, lines 8-30).

Regarding claim 9, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed –*generating hard copy book production information* -- (col.9, lines 12-44, col. 10, lines 45-67).

Regarding claim 10, which depends on claim 1, Warmus discloses using commands –*printing information* -- in a press file to create the finished books or book versions (col. 11, lines 45-51).

Regarding claim 11, which depends on claim 9, Warmus discloses creating the finished books or book versions in a “saddle-stitch” format –*binding information* -- (col. 9, lines 12-22).

Regarding claim 12, which depends on claim 1, Warmus discloses using a RIP processor for converting the book page files into bitmap page files –*creating a bitmap of the book block* -- (col. 8, lines 63-67).

Regarding claim 13, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files –*creating a bitmap of the book block* -- (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B).

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Regarding claim 14, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed –*generating hard copy book production information* -- (col.9, lines 12-44, col. 10, lines 45-67).

Regarding claim 15, which depends on claim 1, Warmus discloses using a format, having watermarks and barcode—*security information*--, for the book pages to be printed (col. 29, lines 22-35, col. 30, lines 6-12).

Regarding claim 16, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a CRT or LCD display –*book presentation information comprises viewing capabilities* -- (col. 7, lines 24-42).

Regarding claim 17, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a printer – *book presentation information comprises printing capabilities* -- (col. 7, lines 24-42).

Regarding claim 18, which depends on claim 1, Warmus discloses sending the book files to a remote location via the Internet –*providing access to said book via an electronic link* -- (col. 7, lines 34-52).

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Regarding claim 19, which depends on claim 1, Warmus discloses sending the book files, via email, to a remote location via a computer network —*delivering said book to a predefined destination* -- (col. 7, lines 34-52).

Claim 20 is directed towards a computer system for implementing the steps found in claim 1, with the exception of a *book reproduction workflows*—which is taught by the method for producing books that includes several conversion and other production steps-- *book reproduction workflows* --, as taught by Warmus (col.10, lines 45-col.11, line50, and therefore is similarly rejected.

Claims 21-22, and 28-38 are directed towards a computer system for implementing the steps found in claims 2-3, 9-13, 9, 15-19 respectively, and therefore are similarly rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-8, and 23-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Dickmeyer et al, hereinafter Dickmeyer (Pat. # 6,413,100 B1, 7/2/2002, filed on 8/8/2000).

Regarding claim 4, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book title*. However, Dickmeyer teaches providing the title of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 5, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book author*. However, Dickmeyer teaches providing the author of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 6, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines

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63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publisher* However, Dickmeyer teaches providing the publisher of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 7, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the International Standard Book Number*. However, Dickmeyer teaches providing the ISBN of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 8, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publishing date*. However, Dickmeyer teaches providing the

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copyright date of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Claims 23-27 are directed towards a computer system for implementing the steps found in claims 3-8 respectively, and therefore are similarly rejected.

Response to Arguments

11. Applicant's arguments filed 7/19/2006 have been fully considered but they are not persuasive. Regarding claim 1, the Applicants submit that Warmus fails to teach the solution-independent format devoid of formatting and any particulars unique to an originator (pages 11-12). The Examiner disagrees, because Warmus discloses converting the stripped template file into a PDL file, which is widely used to print documents—*converting said book files to have a solution-independent, intermediate format, in a universal format, devoid of said customized formatting and any particulars unique to an originator of said complete book file* (col. 10, lines 45-67, col.11, lines 1-10). The file contains information specifying the positioning of fixed information—*storing said solution-independent, intermediate formatted book file along with book identification information* (generic or independent format with information identifying fixed positioning) *as a mastered book*. The converted file lacks or is devoid of information used to customize the book.

Claim 20 is rejected at least based on the same rationale submitted above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

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Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for **all** Formal communications intended for entry)



CESAR PAULA
PRIMARY EXAMINER
9/19/06